REMARKS

Formal Matters

Claims 1-10 and 19-42 are pending after entry of the amendments set forth herein.

Claims 1-10 and 19-42 were examined. Claims 1-10 and 19-31 were allowed, and Claims 32-42 were rejected.

Claim 32 has been amended. Support for the amendment can be found in the claims as originally filed and throughout the specification at, for example, page 34, paragraph 132, and page 35, paragraph 133.

Claim 37 has been cancelled.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

Allowable Subject Matter

Applicants wish to extend their gratitude to the Examiner for indicating that Claims 1-10 and 19-31 are directed to allowable subject matter.

Rejections Under §112, First Paragraph

Claims 32-37

The rejection of Claims 32-37 under 35 U.S.C. § 112, first paragraph has been maintained for allegedly comprising new matter in claiming the use of a broad genus of nuclear export inhibitors. This rejection is respectfully traversed as applied and as it may be applied to the pending claims.

With respect to compounds that block nuclear export, Applicants note that the specification provides at least two examples of agents, leptomycin B (LMB) and trichostatin A (TSA), which block nuclear export (see specification on page 34, paragraph 132 through page 38, paragraph 141. Moreover, Figure 3I also shows that in the presence of leptomycin B or trichostatin A, nuclear export of GFP-RelA is blocked. Furthermore, research articles published prior to the filing of the present application further support Applicants argument that other agents that block nuclear export were well known in the art at the time the present application was filed

(see for example, Finley et al., JBC 104:189-200 (1987) and Pasquinelli et al., PNAS, 94:14394-14399 (1997), cited in the Response filed on November 23, 2004).

However, in the spirit of expediting prosecution and without conceding to the correctness of the rejection, Claim 32 has been amended to recite "contacting a candidate agent with a eukaryotic cell in vitro, wherein the contacting is performed in the presence of leptomycin B or trichostatin A".

Support for the amendment can be found in the claims as originally filed and throughout the specification at for example, page 34, paragraph 132 through page 34 paragraph 133, in which a working example describes use of leptomycin B or trichostatin A for detecting the level of deactylated RelA. Accordingly, this amendment introduces no new matter and the specification provides literal support for the use of leptomycin B or trichostatin A as recited in the claims.

As such, in the view of the remarks made herein and the amendments to the claims, Applicants respectfully request that this rejection be withdrawn.

Claims 38-42

The rejection of Claims 38-42 under 35 U.S.C. § 112, first paragraph, has been maintained for allegedly comprising new matter, and for allegedly changing the scope of the recited method, requiring a new search. This rejection is respectfully traversed as applied and as it may be applied to the pending claims.

In particular, the Office Action states the following:

> **the instant specification discloses the use of the specifically recited "anti-acetylated lysine antibody" only in the context of a Western blot where the acetylated RelA was obtained by immunoprecipitation with a different antibody specific for a T7 tag fused to RelA. Therefore, there does not appear to be literal or inherent support for the use of an anti-acetylated lysine antibody as recited in the proposed amendment. At a minimum, the proposed amendment of the claims would require searching the art for other proteins within mammalian cells that might be identified by an anti-acetylated lysine antibody as used in the proposed method of claim 38 (e.g. with regard to enablement).**

(Advisory Action, page 2). However, Applicants respectfully disagree.

Applicants note that the specification provides ample support for the claim amendment and the recited method. In particular, the specification at, for example, on page 19, paragraph [0082], states the following:

> In another embodiment, the cells are modified to express a NF-κB-regulated reporter construct, and the effect of candidate agent upon reporter construct expression assessed by detection of a reporter construct gene product (*e.g.*, reporter gene transcript or reporter polypeptide). The assay is generally conducted with appropriate controls, *e.g.*, using host cells further modified to express HDAC3. Exemplary reporter constructs include, but are not necessarily limited to, green fluorescent protein (GFP), luciferase, β-galactosidase, CAT, and the like. **Acetylation levels of RelA may be detected by using an anti-acetylated lysine antibody**. The effect of a candidate agent on the acetylation level of RelA can by detected by using this antibody.

Accordingly, this amendment does not introduce new matter.

Moreover, Applicants also note that the specification, and in particular the recited passage, provides adequate literal support for such a method. The Advisory Action states that the instant specification only discloses the use of the anti-acetylated antibody only in the context of a western-blot. However, the recited section of the specification is directed to cell-based assays that generally involve contacting a cell that produces NF-κB with a test agent, and determining the effect of the candidate agent upon NF-κB activity via deacetylation of the RelA subunit (See specification, page 18, paragraph 77). Therefore, the specification provides literal support for the use of an anti-acetylated lysine antibody as recited in the claims.

As such, in the view of the remarks made herein and the amendments to the claims, Applicants respectfully request that this rejection be withdrawn.

Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number UCAL-234.

Respectfully submitted,
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Date: Dec. 22, 2004

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